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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,001	01/16/2004	Eugenio Cruz Garcia	5724.012.21-US	5034
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MCKENNA LONG & ALDRIDGE LLP				
1900 K STREET, NW				
WASHINGTON, DC 20006				
EXAMINER				
LAUX, JESSICA L				
ART UNIT		PAPER NUMBER		
3635				
MAIL DATE		DELIVERY MODE		
06/21/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,001

Applicant(s)

GARCIA, EUGENIO CRUZ

Examiner

JESSICA LAUX

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 14, 16-18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 14, 16-18 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date 3/10/2011
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/8/2011 has been entered.

Response to Arguments

Applicant's arguments filed 6/8/2011 have been fully considered but they are not persuasive.

Applicant's argument that the cited passages of Piacente does not disclose "a surface texture that varies in accordance with a visual pattern printed on the at least one cellulose sheet, wherein the visual pattern imitates another product" is not persuasive since Piacente is not relied upon for teaching a printed pattern on a cellulose sheet. Piacente is relied upon for the teaching of a surface texture in register with, or that varies in accordance with, a visual pattern printed on a substrate. This is clearly disclosed in Piacente in the cited passages, where the cited passages are not modifying each other, but rather demonstrating what is known in the art as taught by Piacente.

Martensson discloses a patterned cellulose sheet, and Piacente discloses the impressions that vary according to a printed pattern. It is the combination of the

references as presented in the office action that disclosed the presently claimed invention. Therefore, applicant's arguments are not persuasive.

Applicant's arguments that Piacente and Martensson are not combinable is not persuasive. Piacente discloses that it is known to provide embossing by varying techniques, indicating that one of skill in the art would be aware of suitable techniques for embossing in register and that undue experimentation would not be required to achieve the predictable result of a floor board with patterned cellulose sheet having embossing in register with the pattern. Additionally it is noted that Piacente and Martensson both disclose a decorative product useful for flooring and that the combination of impressions that vary according to a pattern within the product would not render the product of Martensson unusable as a floor product.

In response to applicant's argument that Martensson and Piacente are nonanalogous is not persuasive. Martensson and Piacente are both concerned with decorative substrates useful as a flooring product and therefore are analogous.

Applicant's argument that Martensson at best merely discloses chamfering an edge of a board and therefore does not disclose the perimeter area as claimed is not persuasive. The term "perimeter area" is broad and as interpreted by the office is an area (of unspecified dimension that could just include chamfer 14 or a portion of surface 13 and chamfer 14) at a perimeter, or outer portion, of the board which can be along one edge. Therefore, Martensson does disclose the claimed contoured edge at a perimeter area of the board.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-14, 16-18, 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (6146252) in view of Piacente et al (5858160).

Claims 13-14, 16-18, 20-23: Martensson discloses a laminated material useful as a decorative covering as a floor, wall, ceiling or furniture surfacing (Col. 1, lines 1-21) comprising at least one cellulose sheet impregnated with resin that is mechanically pressed and cut into a product (Col. 3, lines 21-44 and claims 15-19) said product having a fiberboard core (Col. 1, lines 14-20). The product includes a surface having a perimeter area (a portion a perimeter, or outer, area of the board that is either 14 or an area including a combination of 13 and 14 and the outermost portion of the panel) with an edge contour (where the edge contour is the chamfer 14) and an interior region (generally at 13 as seen in figure 2); and where the edge contour is a machined edged contour with a linear shape (14 and 17,18, Figure 2 and Col. 1, lines 21-28), wherein the perimeter is relieved such that a portion of the linear edge contour lies below the interior region (as seen in the figures). The laminate also comprises one patterned sheet (Col. 3, lines 26-28).

Martensson does not disclose the laminated material to have a surface texture that varies in accordance with the visual pattern that imitates another product.

Piacente et al. discloses a decorative panel useful for flooring that has a visual pattern printed on a substrate (Col. 1, lines 26-35) and where that panel further has a surface texture with raised and depressed deformities that vary in accordance with a visual pattern that imitates another product (Col. 3, lines 26-28; Col. 2, line 66 – Col. 3, line 3; Col. 1, lines 53-57).

In view of Piacente et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the top surface of Martensson's floor panel to have pattern be an ink printed visual pattern on the cellulose sheet and to form impressions that follow the printed pattern to enhance the realistic effect of the imitated décor pattern (where Piacente discloses that it is common practice to include impressions on a floor covering product as a means for adding decorative appeal and further utility; Col. 1, lines 53-55).

It should be noted that the limitations “mechanically pressed and cut into a product” and “has been pressed below” and “printed pattern” are considered product-by-process limitations. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985). In the instant case the claimed invention is the same as or obvious from a product of the prior art, where the prior art discloses a cut product having edge contours below the

interior region, even though the prior product may have been made by a different process.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA LAUX whose telephone number is (571)272-8228. The examiner can normally be reached on Monday thru Thursday, 9:00am to 5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on 571-272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jessica Laux/
Primary Examiner, Art Unit 3635

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